

REMARKS/ARGUMENTS

Reconsideration of this application and entry of this Amendment are requested. Claims 8 and 15-26 are pending in the application of which claims 19-22 have been withdrawn, the remaining claims being rejected on the basis of prior art. This Amendment addresses the two prior art-based rejections in the outstanding Official Action and proposes to amend each of the independent claims as indicated above.

Rejection based on Komorita JP 53-4023

In the Official Action, pages 2 – 3, claims 8, 15 – 18 and 23 – 26 are rejected as obvious over Komorita JP 53-4023. On page 5 of the Action the examiner says that Applicant's arguments filed February 24, 2003 are not persuasive because Applicant's present claims do not limit the amount of HfO₂.

In response to the examiner's comments, each of the present independent claims 23, 24, 25 and 26 are above amended to specify that the optical glass does not contain HfO₂ in order to clearly distinguish these claims from Komorita JP 53-4023.

While there is no specific support in the application for the precise wording of excluding HfO₂, it is believed that the Applicant is entitled to exclude subject matter of prior art pursuant to the decision of *In re Johnson*, 194 USPQ 187 (CCPA 1977). In that case, the court quoted from its decision in *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) as follows:

"Inventions are constantly made which turn out not to be patentable, and Applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."

The court went on to state:

It is for the inventor to decide what bounds of protection he will seek. *In re Saunders*, 58 CCPA 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 220 (1971). To deny applicants the benefit of the grandparent application in this case would, as this court said in *Saunders*:

'... let form triumph over substance, substantially eliminating the right of an Applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed.' " (Emphasis in the original)

In the *Johnson* case, the Appellants narrowed their claims to avoid them reading on a lost interference count (which was then prior art to them). The court noted that the Appellants were merely "excising the invention of another" to which they were not entitled, and were not "creating an 'artificial subgenus' or claiming 'new matter'".

Rejection based on Takahashi JP 54-90218 in view of Komorita JP 53-4023

Claims 8, 15 – 18, 24 and 26 are rejected as being unpatentable over Takahashi JP 54-90218 in view of Komorita JP 53-4023. Of these claims, independent claim 23 is not rejected while independent claim 26, also not rejected, specifies Nb₂O₅ as an essential glass component.

In contrast to the rejected claims, Takahashi JP 54-90218 teaches nothing concerning the presence of Nb₂O₅, which follows that it is necessary, to support the rejection, for the examiner to refer to Komorita JP 53-4023 for the idea of incorporating Nb₂O₅ to the optical glass of Takahashi JP 54-90218.

However, the glass described in Komorita JP 53-4023 contains 0.1 to 25 % of HfO₂ as an essential component and as such fundamentally differs from the glass of Takahashi JP 54-90218 in glass composition since the glass of Takahashi JP 54-90218 does not require that any HfO₂ be contained as an essential component.

Takahashi JP 54-90218 and Komorita JP 53-4023 are different in glass composition as discussed above, so that there is little necessity for combining these references JP 54-90218 and 53-4023.

The fundamental question not addressed in the Action is the failure to establish a *prima facie* case of obviousness. In order to do so, the art cited must include the following elements: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

"Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 966 F.2d 656, 658-9, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992).

The Examiner argues that the glass of each of claims 24 and 26 can be reached by simply taking Nb₂O₅ out of the glass described in Komorita JP 53-4023 and incorporating 0.5 to 1.5 % of the Nb₂O₅ into the glass described in Takahashi JP 54-90218. This position is not reasonable for at least the following reasons.

Komorita JP 53-4023 describes that the amount of Nb₂O₅ is 0 to 20 %, clearly a non-essential component. That Nb₂O₅ is an arbitrary (optional) component is evidenced by the data contained in the reference itself – the glasses of Example Nos. 1 - 44 of Komorita JP 53-4023, only No. 21 and No. 32 glasses contain Nb₂O₅ and remaining 42 glasses do not contain Nb₂O₅. Komorita JP 53-4023 has little interest of positively (constantly) adding Nb₂O₅.

The Examiner's position is that Nb₂O₅ described in Komorita JP 53-4023 may be simply added to the glass of Takahashi JP 54-90218. However, this position is simplistic and is not technically sound. That is because the composition of a glass is 100 % as a total, and if Nb₂O₅ should be added to the glass of Takahashi JP 54-90218, it is necessary to reduce some existing component(s) in an amount corresponding to the amount of the Nb₂O₅ added. The question remains, which component or components and how much are they reduced? In this case, the glass as a whole may get out of shape in balance. The Examiner's position does not account for the reality that the addition of a new component must necessarily be followed by reducing an existing component corresponding to the addition of the new one. The Examiner's position is not technically sound.

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The mere fact the references can be modified or combined is not enough. As stated by the Court in *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992) (emphasis added):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.


Thus, the mere fact that references can be combined or modified (Applicants believe they cannot be) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed.Cir. 1990); MPEP § 2143.01. Hence, the Examiner's attempt to combine the cited references alone without any suggestion in the references of the desirability of the modification is improper and should be withdrawn.

For the above reasons, it is respectfully submitted that claims 8, 15-18 and 23-26 define patentable subject matter. Reconsideration, entry of this Amendment and allowance are solicited. Applicant requests process claims 19-22 be rejoined once allowable subject matter is indicated.

Respectfully submitted,

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